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10/601,323

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LZ-75

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02/23/2005

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EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,323

Applicant(s)

BIRO, RAINER

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on January 18, 2005 has been entered. Claims 1, 2, 5 and 9 have been amended. Claims 4 and 6-8 have been cancelled. No claim has been added. Claims 1-3, 5 and 9-19 are still pending in this application, with claim 1 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains: Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 9, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over SHEEKS et al. (U.S. Pat. 1,313,957).

SHEEKS et al. discloses an illumination device having:

- **a main body (as recited in Claim 1), Figure 1, reference character D;**
- **an electric light source (as recited in Claim 1), Figure 1, reference character L;**

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- **the light source being arranged in the main body (as recited in Claim 1), as seen in Figure 1;**
- **a manually actuated operating element (as recited in Claim 1), Figure 4, reference number 26;**
- **the operating element being arranged on the main body (as recited in Claim 1), as seen in Figure 4;**
- **the operating element being configured to control the brightness of the light source (as recited in Claim 1), column 3, lines 41-52;**
- **the operating element being configured to be adjusted by linear movement (as recited in Claim 1), column 2, line 122 to column 3, line 3;**
- **the linear movement being a sliding movement (as recited in Claim 1), column 2, line 122 to column 3, line 3;**
- **the operating element including an adjustable electric resistor (as recited in Claim 1), Figure 4, reference number 17;**
- **the electric resistor controlling the electric current intensity flowing to through the light source (as recited in Claim 1), column 3, lines 45-49;**
- **the electric resistor being a sliding potentiometer (as recited in Claim 1), as seen in Figure 4;**

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- **the potentiometer having a sliding contact (as recited in Claim 1), Figure 4, reference number 27;**
- **the sliding contact being secured on the main body (as recited in Claim 1), as seen in Figure 4;**
- **the potentiometer having a winding (as recited in Claim 1), Figure 4, reference number 17;**
- **the winding being movable relative to the sliding contact (as recited in Claim 1), as seen in Figure 4;**
- **the main body having a longitudinal axis (as recited in Claim 2), inherent;**
- **the linear movement of the operating element being realized parallel to the axis of the main body (as recited in Claim 2), as evidenced by Figure 4;**
- **the main body being rod-shaped (as recited in Claim 3), as seen in Figure 1;**
- **the brightness level of the light source being continuously adjustable (as recited in Claim 5), inherent;**
- **a mechanical resistance element (as recited in Claim 9), Figure 4, reference number 27;**
- **the resistance element providing a mechanical resistance when moving the operating element between a rest position**

without illumination output, and an operating position with illumination output (as recited in Claim 9), inherent;

- **an indicator device (as recited in Claim 12), Figure 1, reference number 24;**
- **the indicator device providing visual representation of a brightness level of the illumination device (as recited in Claim 12), as seen in Figure 1;**
- **the indicator device representing the brightness level uniformly in steps (as recited in Claim 13), inherent;**
- **a fastening device (as recited in Claim 14), Figure 2, reference number 6;**
- **the fastening device being for detachably securing the illumination device to objects (as recited in Claim 14), inherent;**
- **at least one of the operating element, the electric resistor, the indicator device and the mechanical resistance element being arranged in the area of the fastening device (as recited in Claim 16), as seen in Figure 1; and**
- **at least one of the operating element, the electric resistor, the indicator device and the mechanical resistance element being substantially integrated into the fastening device (as recited in Claim 17), as seen in Figure 2.**

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In addition, the winding of SHEEKS et al. is stationary with respect to the main body, the sliding contact being movable with respect to such winding.

SHEEKS et al. discloses all the limitations of the claims, except the sliding contact being stationary with respect to the main body, the winding being movable relative to the sliding contact (as recited in Claim 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the sliding contact stationary with respect to the main body, since it has been held by the courts that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). In this case, operation of the claimed sliding potentiometer to control the electric current flowing through the light source, is achieved by the relative movement of the sliding contact with respect to the winding, the relationship between the sliding contact and the main body is irrelevant to the operation of the claimed device.

3. Claims 1-3, 5, 9-13, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILKINSON (U.S. Pat. 2,416,558).

WILKINSON discloses an illumination device having :

- **a main body (as recited in Claim 1)**, Figure 1, reference number 11;

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- **an electric light source (as recited in Claim 1), column 2, lines 27-29;**
- **the light source being arranged in the main body (as recited in Claim 1), column 2, lines 27-29;**
- **a manually actuated operating element (as recited in Claim 1), Figure 1, reference number 23;**
- **the operating element being arranged on the main body (as recited in Claim 1), as seen in Figure 1;**
- **the operating element being configured to control the brightness of the light source (as recited in Claim 1), column 2, lines 29-33;**
- **the operating element being configured to be adjusted by linear movement (as recited in Claim 1), column 2, lines 4-6;**
- **the linear movement being a sliding movement (as recited in Claim 1), column 2, lines 4-6;**
- **the operating element including an adjustable electric resistor (as recited in Claim 1), Figure 1, reference number 14;**
- **the electric resistor controlling the electric current intensity flowing to through the light source (as recited in Claim 6), column 2, lines 29-34;**
- **the electric resistor being a sliding potentiometer (as recited in Claim 1), as seen in Figure 1;**

CANCELLED

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- **the potentiometer having a sliding contact (as recited in Claim 1), Figure 3, reference number 27;**
- **the sliding contact being secured on the main body (as recited in Claim 8), as seen in Figure 3;** *CANCELLED*
- **the potentiometer having a winding (as recited in Claim 1), Figure 1, reference number 14;**
- **the winding being movable relative to the sliding contact (as recited in Claim 1), as seen in Figure 3;**
- **the main body having a longitudinal axis (as recited in Claim 2), inherent;**
- **the linear movement of the operating element being realized parallel to the axis of the main body (as recited in Claim 2), as evidenced by Figure 1;**
- **the main body being rod-shaped (as recited in Claim 3), as seen in Figure 1;**
- **the brightness level of the light source being continuously adjustable (as recited in Claim 5), column 2, lines 29-34;**
- **a mechanical resistance element (as recited in Claim 9), Figure 2, reference number 28;**
- **the resistance element providing a mechanical resistance when moving the operating element between a rest position**

- without illumination output, and an operating position with illumination output (as recited in Claim 9), column 2, lines 17-22;**
- **the operating element including a spring, Figure 3, reference number 27;**
 - **the spring exerting a force when moving the operating element between the rest position and the operating position (as recited in Claim 10), as evidenced by Figure 3;**
 - **the mechanical resistance element being a profile change on the main body (as recited in Claim 10), Figure 2, reference number 28;**
 - **an indicator device (as recited in Claim 12), Figure 1, reference number 23;**
 - **the indicator device providing visual representation of a brightness level of the illumination device (as recited in Claim 12), as seen in Figure 3;**
 - **the indicator device representing the brightness level uniformly in steps (as recited in Claim 13), inherent;**
 - **the main body including a housing (as recited in Claim 18), Figure 1, reference number 11; and**
 - **the housing receiving at least one battery for powering the light source (as recited in Claim 18), column 1, lines 33-35.**

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In addition, the winding of WILKINSON is stationary with respect to the main body, the sliding contact being movable with respect to such winding.

WILKINSON discloses all the limitations of the claims, except the sliding contact being stationary with respect to the main body, the winding being movable relative to the sliding contact (as recited in Claim 1), the profile change being a protrusion (as recited in Claim 11), or the illumination device being in the form of one of an otoscope, an ophthalmoscope, and a manual slit lamp (as recited in Claim 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the sliding contact stationary with respect to the main body (as recited in Claim 1), since it has been held by the courts that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). In this case, operation of the claimed sliding potentiometer to control the electric current flowing through the light source, is achieved by the relative movement of the sliding contact with respect to the winding, the relationship between the sliding contact and the main body being irrelevant to the operation of the claimed device.

Regarding the profile change being a protrusion (as recited in Claim 11), it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a protrusion on the main body instead of the patented recess, since it has been held by the courts that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA

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1955). In this case, WILKINSON shows a recess 28 formed on the main body 11, such recess matching enlarged portion 26 to provide a mechanical resistance against movement of the operating member 23 from a rest position to an operating position (as shown in Figure 3). Reversing the arrangement of such recess/enlarged portion structure.

Regarding the illumination device being in the form of one of an otoscope, an ophthalmoscope, and a manual slit lamp (as recited in Claim 19), it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the illumination device of WILKINSON, since the patented structure includes all the claimed structural limitations. Selecting a specific application would amount to a recitation of the intended use of the patented invention, without resulting in any structural difference between the claimed invention and the structure disclosed by WILKINSON, and therefore fails to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

4. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILKINSON (U.S. Pat. 2,416,558) and McDERMOTT (U.S. Pat. 4,517,628).

WILKINSON discloses, or suggests, all the limitations of the claims (as detailed in Section 3 of the instant Office Action), except:

- a fastening device (as recited in Claim 14);

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- the fastening device being for detachably securing the illumination device to objects (as recited in Claim 14);
- the fastening means being a clip (as recited in Claim 15);
- at least one of the operating element, the electric resistor, the indicator device and the mechanical resistance element being arranged in the area of the fastening device (as recited in Claim 16); and
- at least one of the operating element, the electric resistor, the indicator device and the mechanical resistance element being substantially integrated into the fastening device (as recited in Claim 17).

McDERMOTT discloses an illumination device having:

- **a main body (as recited in Claim 1), Figure 2, reference number 11;**
- **an electric light source (as recited in Claim 1), Figure 2, reference number 16;**
- **the light source being arranged in the main body (as recited in Claim 1), as seen in Figure 2;**
- **a manually actuated operating element (as recited in Claim 1), Figure 1, reference number 41;**
- **the operating element being arranged on the main body (as recited in Claim 1), as seen in Figure 2;**

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- **the operating element being configured to control operation of the light source (as recited in Claim 1), column 5, lines 10-15;**
- **the operating element being configured to be adjusted by linear movement (as recited in Claim 1), column 5, lines 10-15;**
- **a mechanical resistance element (as recited in Claim 9), Figure 10, reference number 56;**
- **the resistance element providing a mechanical resistance when moving the operating element between a rest position without illumination output, and an operating position with illumination output (as recited in Claim 9), column 5, lines 10-15;**
- **an indicator device (as recited in Claim 12), Figure 2, reference number 41;**
- **the indicator device providing visual representation of the status of the illumination device (as recited in Claim 12), as evidenced by Figure 7;**
- **a fastening device (as recited in Claim 14), Figure 2, reference number 46;**
- **the fastening device being for detachably securing the illumination device to objects (as recited in Claim 14), column 4, lines 21-25;**
- **the fastening means being a clip (as recited in Claim 15), Figure 2, reference number 46;**

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- **at least one of the operating element, the indicator device and the mechanical resistance element being arranged in the area of the fastening device (as recited in Claim 16), as seen in Figure 7; and**
- **at least one of the operating element, the indicator device and the mechanical resistance element being substantially integrated into the fastening device (as recited in Claim 17), as seen in Figure 7.**

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the teachings of WILKINSON and McDERMOTT to obtain an illumination device capable of adjusting the intensity of the light source and been clipped over items of clothing, as per the teachings of both WILKINSON and McDERMOTT.

Response to Arguments

5. Applicant's arguments filed January 18, 2005 have been fully considered but they are not persuasive.

6. Regarding the Examiner's rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by SHEEKS et al. (subject matter now rejected under 35 U.S.C. 103(a) as obvious over the cited reference), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the sliding contact being

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stationary with respect to the main body, with the winding being movable relative to the sliding contact.

7. In response to applicant's arguments the Examiner respectfully advises the applicant that it has been held by the courts that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). In this case, having the sliding contact move against the winding, or having the winding move against the sliding contact was considered irrelevant to the operation of the claimed device. Fixing the winding and moving the sliding contact (as disclosed by SHEEKS et al.), or fixing the sliding contact and moving the winding (as claimed) were considered functionally equivalent and obvious expedients of the patented electric current controlling structure.

8. With respect to claims 2, 3, 5, 9, 12-14, 16 and 17 the applicant presents no arguments, except stating that such claims are dependent upon claim 1 and would be allowable when/if the independent claim is allowed.

9. Regarding the Examiner's rejection of Claim 1 under 35 U.S.C. 102(b) as being anticipated by WILKINSON (subject matter now rejected under 35 U.S.C. 103(a) as obvious over the cited reference), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the sliding contact being stationary with respect to the main body, with the winding being movable relative to the sliding contact.

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In response to the arguments regarding the Examiner's rejection of Claim 1 as being unpatentable over WILKINSON, the applicant is respectfully directed to Section 7 of the instant Office Action where such arguments are addressed.

With respect to claims 2, 3, 5, 9-13, 18 and 19 the applicant presents no arguments, except stating that such claims are dependent upon claim 1 and would be allowable when/if the independent claim is allowed.

10. Regarding the Examiner's rejection of claims 14-17 under 35 U.S.C. 103(1) as obvious over WILKINSON in view of McDERMOTT, the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the sliding contact being stationary with respect to the main body, with the winding being movable relative to the sliding contact.

In response to the arguments regarding the Examiner's rejection of Claim 1 as being unpatentable over WILKINSON, the applicant is respectfully directed to Section 7 of the instant Office Action where such arguments are addressed.

With respect to claims 15-17 the applicant presents no arguments, except stating that such claims are dependent upon claim 14 and would be allowable when/if the claim 14 is allowed.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negrón whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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~~for~~
Inr

February 7, 2005


JOHN ANTHONY WARD
PRIMARY EXAMINER